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CENTRAL FAX CENTER

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Application No.: 09/892,639
Art Unit: 2642Docket No.: 1344.40298X00
Page 6**REMARKS**

Reconsideration and allowance of this application, as amended, is respectfully requested.

This Amendment is in response to the Office Action dated October 5, 2004. By the present Amendment, the claims have been amended to clarify the invention.

Briefly, the present invention is directed to an improved arrangement to permit an electronic device, such as a mobile telephone handset, to operate in conjunction with a hearing aid for the hearing impaired. As discussed in the background of the invention on page 1 of the specification, previous devices for this purpose have utilized induction coils in separate battery packs for the mobile telephone handsets (such as in the case of USP 5991420 to Stern, which is the primary reference relied on by the Examiner in the Office Action) or through the use of an induction loop worn around a user's neck and plugged into the handset. As such, such previous arrangements for assisting the hearing impaired have required additional units that have added inconvenience to the use of the induction coil operating with a hearing aid.

In order to provide a more convenient arrangement for using a mobile telephone handset with a hearing aid, the present invention provides a cover for the mobile telephone handset which includes means, such as an induction coil, for generating a magnetic field signal for the hearing aid. Referring to Fig. 1, for example, a front cover, designated by the numeral 2, is provided for the telephone handset 1. As discussed on page 6, line 1 et seq. of the specification, this front cover can be used as a replacement for a standard front cover typically provided for telephone handsets. As discussed on page 5, line 31 et seq., the majority of the

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population does not suffer from impaired hearing, and, as such, mobile telephone handsets are sold with standard covers. The present invention provides a custom replacement cover that can be used instead of a standard cover to operate in conjunction with a hearing aid. This provides easy modification of standard mobile telephone handset by simply providing a user releasable cover in accordance with the present invention that permits immediate operation with a user's hearing aid.

Fig. 3 provides additional details for a front cover in accordance with the present invention. As shown there, an induction coil 26 is provided around an aperture 24 on the upper portion of the front cover (which aperture 24 is provided for the speaker 12 shown on the handset 1 in Fig. 1). In conjunction with this, a driver amplifier 28 for the induction coil 26 is provided on the front cover. As also shown in Figs. 3 and 4, a connector 29 is provided to connect to the audio signal from the coder/decoder 18 of the telephone handset (see Fig. 2) and power from the battery (via terminals 31 and 32, as discussed in page 4, line 24 et seq.). As discussed on page 4, line 14 et seq., the cover 2 in this particular embodiment is a front cover which includes apertures 22 for the keypad of the telephone handset. This front cover is intended to be used on the surface of the handset which will face the user's ear, as also discussed on page 4.

Reconsideration and allowance of claims 1-10 and the newly presented claims 11-19 over US Patent 5,991,422 to Stern is respectfully requested. By the present Amendment, each of the independent claims 1, 9 and 10 (and the newly presented independent claim 14) has been drafted to specify that the cover for the mobile telephone handset (or electronic device in the case of claim 10) is a user-releasable cover. In addition, it has been further emphasized, by the present

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Amendment, that the induction coil (or the means for generating a magnetic field signal, in the case of claim 14) is located on this user-releasable cover. As such, it is respectfully submitted that the distinctions over the cited reference to Stern are even further emphasized by these amendments.

With regard to the Stern reference, it is very clear that this reference is directed to a battery pack, not a cover for a mobile telephone handset (or electronic device). The very title of the Stern patent is "Battery Pack with Audio Coil." The first sentence of the abstract specifies that "A battery pack is provided for use with a mobile phone. The field of the invention specifies that the invention is directed to "a battery for use with a mobile phone." Similarly all of the claims are directed to "a battery pack." As such, it is completely clear from the teachings of the Stern patent that it is directed to a battery pack, not to a cover for mobile telephone handset.

It is respectfully submitted that the term "cover" with the regard to the use of mobile telephone handsets is a very well recognized term, quite distinct from the well recognized meaning for the term "battery pack." This has been further clarified by the present Amendment which specifies that the cover is a "user-releasable cover," and that the induction coil (or means for generating a magnetic field signal) is located on the cover. This clearly directs one skilled in this art to the well known type of front cover that is releasable from the mobile hand unit (as shown in the exploded view of Fig. 1 of the drawing of the present application). It is quite well known to replace such covers, generally for cosmetic purposes such as color preferences. Therefore, it is respectfully submitted that the present claims very clearly define a different structure than that taught in Stern, which would be readily recognized by those skilled in the art, particularly with the present claim amendments.

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The significance of this difference is that the present invention permits the easy replacement of a standard cover with the custom cover including the induction coil of the present invention to assist people with hearing impairment. This replacement of the cover, with the induction coil 26, does not add to the size or inconvenience of using the mobile telephone handset. As such, the fact that the induction coil is provided in an easily replaceable cover represents a completely different solution to the problem than that provided by the Stern reference. As admitted by the Office Action "it is not clear whether the device [of Stern] is on the cover of the mobile phone or placed elsewhere." As such, the reference clearly does not support the specific features defined by the present claims of providing the induction coil on a user replaceable cover.

Beyond this, what is very clear from the Stern reference is that the induction coil is provided in a battery pack. The battery for a mobile telephone is generally a separate unit, and not regarded as part of the "cover" for the mobile telephone. As such, it would require a complete modification of Stern to provide the induction coil on the cover for the mobile telephone, as opposed as to providing it in the battery pack, as specified by Stern.

The dependent claims such as 7 and 8 define even further distinctions with regard to the cover. In particular, these claims (as well as new claims 11, 12, 15 and 16) particularly define that the cover in questions is a front cover facing toward the user's ear. This is completely different than the typical location for a battery pack for a mobile telephone handset. Therefore, it is respectfully submitted that these dependent claims even further define over the Stern reference.

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Newly presented dependent claims 17-19 even further define distinctions in terms of the arrangement, shown in Fig. 3, of the induction coil being located adjacent a speaker aperture. This is shown by the induction coil 26 being adjacent the speaker aperture 24 in the upper portion of Fig. 3, for example. This location of the induction coil adjacent the speaker aperture is particularly advantageous for operation in conjunction with an hearing aid, and is completely lacking from the Stern reference.

In the Office Action, although it is recognized that Stern does not actually teach locating an induction coil on a cover, it is stated:

"However, even if the cover were not where the devices attach, it would have been obvious to one of ordinary skill in the art to incorporate the device wherever it was deemed necessary."

It is respectfully submitted that this would require complete reliance of the Applicants' own teachings since nothing in Stern, or any other cited prior art, at all suggest the location of the induction coil (or the means for generating a magnetic field signal) on a user releasable cover for a mobile telephone handset (or electronic device).

As set forth in MPEP 2143.01:

"Obviousness can only be established by confining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or in implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

As appears to be recognized from the Office Action, the Stern reference provides absolutely no "teaching, suggestion or motivation" for this modification to arrive at the claimed invention. As pointed out at the outset of these remarks, Stern is very clearly limited to providing the inductor coil in the battery pack, and provides no

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suggestion whatsoever that the location could be changed to a user releasable cover for a mobile telephone handset. Therefore, it appears that the basis for the reasoning in the rejection is "knowledge generally available to one of ordinary skill in the art." With regard to this, MPEP 2144.03 specifies that the use of such common knowledge should be "in limited circumstances." MPEP 2144.03 goes on to state that "the circumstances should be rare." More specifically, MPEP 2144.03 states that reliance on common knowledge in the art:

"should only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known."

The Manual goes on to state that the position "taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute."" It is respectfully submitted that this is not at all the case here.

As discussed above, Stern very clearly emphasizes the fact that his invention is directed to the use of an induction coil in battery packs. There is absolutely in the record to meet the requirement of an "instant and unquestionable demonstration" of it being well know to locate the coil in a cover instead of a battery pack. Quite to the contrary, the only suggestion for locating the induction coil (or means for generating a magnetic field signal) in a user releasable cover is provided by Applicants' own teachings. As noted recently by the CAFC in the case of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002):

"This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to "use that which the inventor taught against its teacher." 61 USPQ 2d at 1434.

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And yet, in the present instance, it is respectfully submitted that the position taken in the Office Action does "use that which the inventor taught against its teacher". As such, it is respectfully submitted that this basis for the rejection is contrary to the requirements of MPEP 2144.03 and the case of *In re Lee*, and, accordingly, reconsideration and removal of these grounds of rejection is respectfully requested.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 1344.40298X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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